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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,806	11/18/2003	Steven E. Lentsch	163.1320USC1	6770

7590 12/21/2004

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EXAMINER	
HARDEE, JOHN R	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/716,806	LENTSCH ET AL.	
	Examiner	Art Unit	
	John R. Hardee	1751	

-- The MAILING DATE of this communication appears on the cover she t with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *40,41,43 and 47-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *40, 41, 43 and 47-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Due to an error on the part of the Office, the first office action was based on an incomplete claim set, and claims 47-52 were not examined. The examiner apologizes for any confusion that may have arisen regarding the allowability of those claims.

2. This action contains grounds of rejection which were not prompted by applicant's amendments. Accordingly, it is NOT FINAL.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 40, 43 and 47-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,673,760 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim is drawn to a rinse agent comprising a sheeting agent as presently claimed, in combination with a humectant comprising at least one of glycerine and sorbitol. The weight ratio of total humectant to

total sheeting agent is greater than 1:3. Claims 43 and 48 are drawn to a wide MW range commonly encountered in EO-PO block copolymer surfactants, and claims drawn to specific sequences of EO and PO blocks are obvious in view of the recitation of EO-PO block copolymers generally. The percentages recited in claim 47 are obvious over the recitation of the combination of sheeting agent and humectant generally. It would have been obvious at the time that the invention was made to make a composition as recited in these claims because claim 8 of the patent generically recites compositions comprising the presently-recited constituents.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 40, 41, 43 and 47-55 re rejected under 35 U.S.C. 103(a) as being unpatentable over Lentsch et al., US 5,880,089. The reference discloses rinse aids for plasticware which comprise a hydrocarbon surfactant and may be liquids (abstract). Suitable "hydrocarbon surfactants" are nonionics, including EO-PO block polymers of MW about 500-about 15,000 (col. 5, lines 1+). Note the specific species disclosed at lines 42 and 49. Regarding the limitations of claim 51, the examiner takes the position that this polymer would be obvious to use in view of the general disclosure of EO-PO block copolymers in the absence of any showing of unexpected results. The nonionic is present at about 8-30% of liquid compositions (Table I, col. 11). Liquid compositions may comprise carriers, including glycerine and propylene glycol. Regarding the use of

both glycerol and propylene glycol, when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results. Regarding the amount of solvent, the examiner takes the position that the use of 60% or more of solvent would be obvious in view of the disclosure of Table I, which teaches that liquid compositions comprise up to 40% of actives. Citric acid may be added (col. 10, line 59). This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim,* 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff,* 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

7. Claims 40, 41, 43 and 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum, US 5,589,099. The reference discloses low foaming rinse aids

comprising an ethylene oxide-propylene block copolymer. The polymer preferably has a molecular weight above 5,000 (col. 4, lines 9-11). Note the structure disclosed at the bottom of col. 3. Regarding the limitations of claims 50 and 51, the examiner takes the position that these polymers would be obvious to use in view of the general disclosure of EO-PO block copolymers in the absence of any showing of unexpected results. Note Table I, in which the nonionic is most preferably present at 10-30% of the composition, and preservative is most preferably present at 0.025-0.2%. In this most preferred embodiment, diluents comprise about 54% by weight of the composition. The diluent is preferably water or water in combination with a compatible solvent. Among the disclosed compatible solvents are propylene glycol and glycerine. Regarding the use of both glycerol and propylene glycol, when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results. Citric acid is a preferred preservative. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition in amounts which read on those recited by applicants. The examiner takes the position that the reference fairly

discloses, albeit indirectly, amounts of propylene glycol and glycerol which would read on the ratios recited in the claims. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim,* 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff,* 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

8. Claims 40, 43 and 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al., US 4,260,528. The reference discloses aqueous high viscosity liquid dishwasher compositions which contain a surfactant, which is preferably polyoxyethylene-polyoxypropylene block copolymers (col. 3, lines 45-47) with a MW of about 1500-3000 and about 0.3% to about 10% of a polyhydric alcohol, which may be glycerol or propylene glycol (col. 4, lines 56+). The surfactant is present at about 1-25%, preferably about 3-15% (col. 3, lines 41-43). Regarding specific EO-PO block copolymers, the examiner takes the position that the recited polymers would be obvious to use in view of the general disclosure of EO-PO block copolymers in the absence of any showing of unexpected results. See also claims 1, 3, 4, 7 and 8. Regarding the use of both glycerol and propylene glycol, when ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same

fashion as the individual materials, absent unexpected results. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim,* 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff,* 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John R. Hardee
Primary Examiner
December 16, 2004